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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY ALLEN and STEVEN THOMAS

Appeal 2009-001083
Application 10/706,661
Technology Center 3600

Decided: February 25, 2010

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Timothy Allen and Steven Thomas (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1-17. An amendment filed after the final rejection has been refused entry by the

Examiner in an Advisory Action mailed January 29, 2007. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

Appellants' claimed invention pertains to a lubrication system for a transmission and transfer case in a driveline that directs power to forward and rear axles. Spec. 1, ll. 6-10. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A system for lubricating components of a drive line adapted to drive the wheels of a motor vehicle, the system comprising:
 - a power transmission including a first output;
 - a first lubrication circuit;
 - a second lubrication circuit;
 - a first sump for containing hydraulic fluid;
 - a transfer case adapted for a drive connection to the first output, including a second sump for containing hydraulic fluid, and a second output adapted for a drive connection to at least one driven wheel;
 - a first pump driveably connected to the second output, hydraulically connected to the first sump and the first lubrication circuit; and
 - a second pump driveably connected to the second output, hydraulically connected to the second sump and the second lubrication circuit.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Smith	US 5,115,887	May 26, 1992
Baxter, Jr.	US 5,702,319	Dec. 30, 1997

The following Examiner's rejections are before us for review:

1. Claims 1-17 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; and
2. Claims 1-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith and Baxter.

Appellants also seek review of the Examiner's objection to the drawings for failing to show every feature of the claimed invention and the Examiner's objection to a Specification amendment for introducing new matter. App. Br. 5, Issues 1 and 2; App. Br. 5-8; Final Office Action, mailed Dec. 18, 2006, at 2-3. As to the Specification objection, Appellants request the Board to order entry of a proposed amendment filed after the final rejection. App. Br. 7-8. These matters are unrelated to the rejections before us on appeal and are reviewable by petition under 37 C.F.R. § 1.181 (*see Manual of Patent Examining Procedure* (MPEP) §§ 1002 and 1201) and are thus not within the jurisdiction of the Board. *In re Mindick*, 371 F.2d 892, 894 (CCPA 1967).

ISSUES

The Examiner rejected the claims on appeal for lack of enablement. The Examiner found that one of ordinary skill in the art could not make and

use the claimed invention because neither the Specification nor the drawings, as originally filed, clearly show or describe the lubrication circuit connections between the sumps and the pumps. Ans. 4, 8. Appellants point to the Specification's description at pages 8 and 9 and Figures 2A and 2B, and contend that "[a] practitioner of ordinary skill in the relevant art would clearly see from the specification and drawings exactly how the circuit connections are made." App. Br. 8-9. Thus, the first issue on appeal is:

Has the Examiner, in rejecting the claims for lack of enablement, failed to establish that one of ordinary skill in the art would have to engage in undue experimentation to make and use the claimed invention?

The Examiner also rejected the claims as obvious. Claim 1 recites a first pump and a second pump driveably connected to the second output, which is the output of the transfer case. The Examiner found that the primary reference, Smith, discloses two pumps, but fails to show the two pumps connected to the transfer case output. Ans. 4. The Examiner further found that Baxter discloses two pumps driven by a common output shaft in the transfer case. *Id.* The Examiner concluded that it would have been obvious to modify the pump connection of Smith to have Baxter's common connection for two pumps "in order to maintain constant lubrication whenever the vehicle is moving with or without the engine running." *Id.* at 5. Appellants contend that there is no basis to combine the references' teachings. App. Br. 11. Thus, the second issue on appeal is:

Has the Examiner failed to articulate reasoning with some rational underpinning to support the legal conclusion of obviousness?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence.

1. Smith discloses a lubrication system for a transmission having a transfer case. Smith, col. 1, ll. 6-10. During normal transmission operation (when the engine is running), Smith's system utilizes a lube pump 54 and a scavenge pump 50 to provide lubrication to the transmission and transfer case components. *Id.*, col. 2, l. 54 – col. 3, l. 3; col. 3, ll. 16-21. The scavenge pump may be electrically driven or driven by the transmission input. *Id.*, col. 3, ll. 9-16

2. Smith explains that, when the vehicle is being towed, the transmission will be inoperable because the engine is not operating. Smith, col. 3, ll. 23-26. Smith further discloses that the lube pump 54 is preferably driven by the vehicle output so that the pump will continue to operate when the vehicle is moving, even during towing operations. *Id.*, col. 3, ll. 30-36. Smith teaches that the disclosed configuration allows the lube pump to deliver lubricating fluid to both the transfer case and transmission during towing. *Id.*, col. 3, ll. 33-46.

PRINCIPLES OF LAW

When rejecting a claim for lack of enablement, “the [United States Patent and Trademark Office] bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application” *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993) (citing *In re Marzocchi*, 439 F.2d

220, 223-24 (CCPA 1971)). The test for compliance with the enablement requirement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Some experimentation, even a considerable amount, is not “undue” if, e.g., it is merely routine, or if the specification provides a reasonable amount of guidance as to the direction in which the experimentation should proceed. *Id.* (quoting *Ex parte Jackson*, 217 USPQ 804, 807 (Bd. App. 1982)). The “undue experimentation” analysis involves the consideration of several factors, including: (1) the quantity of experimentation; (2) the amount of direction or guidance presented; (3) the presence or absence of working examples; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability or unpredictability of the art; and (8) the breadth of the claims. *Wands*, 858 F.2d at 737.

In order to establish obviousness, an examiner must articulate reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS

The rejection of claims 1-17 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement

The independent claims on appeal recite pumps hydraulically connected to sumps and/or lubrication circuits, or the steps of hydraulically connecting the same. For example, claim 1 recites “a first pump . . . hydraulically connected to the first sump and the first lubrication circuit; and a second pump . . . hydraulically connected to the second sump and the

second lubrication circuit.” The Examiner found that the original Specification and drawings fail to show or describe the connections, and that “it is not clear exactly how the circuit connections are made.” Ans. 4. However, the Examiner has not adequately addressed the *Wands* factors or otherwise explained why one of ordinary skill in the art would have to engage in undue experimentation to practice the claimed invention. Even if it is not clear from Appellants’ disclosure exactly how the circuit connections are made, as the Examiner maintains, it does not necessarily follow that undue experimentation would be required to make and use the claimed invention. Therefore, the Examiner has failed to establish a case of non-enablement of claims 1-17, and we are constrained to reverse the rejection.

The rejection of claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over Smith and Baxter

As mentioned above, the Examiner reasons that it would have been obvious to modify the pump connection of Smith to have Baxter’s common connection for two pumps “in order to maintain constant lubrication whenever the vehicle is moving with or without the engine running.” Ans. at 5. However, Smith discloses a system where the lube pump and scavenge pump supply lubrication to the transmission and transfer case components during normal engine-running operations, and where the lube pump supplies both of those components during towing operations. Facts 1-2. Smith’s system – without further modification – maintains constant lubrication whenever the vehicle is moving, with or without the engine running. *Id.* The Examiner has not adequately explained why one of ordinary skill would find it obvious to modify Smith to have a common drive for two pumps in

order to perform a function that is already performed by Smith's existing configuration. Thus, the Examiner's reasoning lacks an articulated, rational underpinning to support the conclusion of obviousness. As such, we cannot sustain the rejection.

CONCLUSIONS

The Examiner, in rejecting the claims for lack of enablement, has failed to establish that one of ordinary skill in the art would have to engage in undue experimentation to make and use the claimed invention.

The Examiner has failed to articulate reasoning with some rational underpinning to support the legal conclusion of obviousness.

DECISION

The decision of the Examiner to reject claims 1-17 is reversed.

REVERSED

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